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10/672,057

09/26/2003

Rami Caspi

2003P08220US

7137

7590

07/16/2007

Siemens Corporation  
Attn: Elsa Keller, Legal Administrator  
Intellectual Property Department  
170 Wood Avenue South  
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EXAMINER

ZEWDU, MELESS NMN

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/672,057

Applicant(s)

CASPI ET AL.

Examiner

Meless N. Zewdu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to RCE***

1. This action is in response to the communication filed on 5/24/07.
2. Claims 1-19 are pending in this action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/672,641. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the features claimed in the instant application are recited, if not in a single claim, in various claims in the copending application. For example, the instant claims 1, 4-9, 14 and 16-19 corresponding to copending claims 1, 4, 7-9, 11, 14, 17, 20-22, 24-25; instant claims 2, 10 and 15 correspond to copending claims 2, 10 and 27; instant claims 3, 11-13 correspond to copending claims 17-19, 29 and 30. It is to be noted that "dial-in" telephone recited in copending claims 21 and 22 does not exclude the "toll-free" telephone claims in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/672,364. Although the conflicting claims are not identical, they are not patentably distinct from each other because the key features, "toll-free" telephone (dial-in telephone), "e-mail" message, "correlation" and "rules", recited in the instant claims are recited, if not in a single claim, in various claims in the copending application (see claims 1, 4, 11, 16, 21, 22, 24). Furthermore, GPS and cellular/wireless network, claimed in the instant claims, are also recited in the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polychronidis et al. (Polychronidis) (US 2003/0018704 A1) in views of McDowell et al. (McDowell) (2002/0035605 A1), Yugami (US 2003/0027583 A1) and Barnett (US 6,958,688 B1).

**As per claim 1:** Polychronidis discloses a telecommunications system, comprising:

a plurality of network clients including a positioning controller (see fig. 1, element 2; page 1, paragraphs 0021 and 0022), wherein examiner considers the one mobile device of the prior art as an exemplary;

a positioning server including a coordinating controller for maintaining a database of network clients to be tracked (see abstract; fig. 2, element 27 and fig. 4, element 41; page 3, paragraph 0032).

wherein said positioning server is adapted to receive position information from said plurality of network clients and distribute presence information related to said position information as one or more text messages to one or more network enterprise devices (see abstract; page 1, paragraph 0022; page 2, paragraph 0026; page 3, paragraph 0032; page 4, paragraph 00). But, Polychronidis does not explicitly teach

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about a database that correlates presence-position information relating to party availability for individual users, as claimed by applicant. However, in a related field of endeavor, McDowell teaches about a gateway that includes various modules, including presence and location modules, pertaining to wireless subscribers (see paragraph 0037); wherein the gateway is a centralized/integrated gateway for providing subscribers with information, including location and presence (see abstract; paragraphs 0008; 0126). Thus the centralized/integrated gateway can be considered as a position-presence **correlation database**. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Polychronidis with that of McDowell for the advantage of integrating location and presence information with instant messaging service (see paragraph 0013). But, Polychronidis in view of McDowell does not explicitly teach about distributing presence information related to position information as one or more e-mail messages to one or more network enterprise devices, as claimed by applicant. However, in a related field of endeavor, Yugami teaches about a mobile device that is capable of transmitting location information via an e-mail to a base station (see entire document, particularly paragraphs 0010; 0018). According to Yugami's reference, location information can be sent to a network (base station) via e-mail without a user's intervention which when applied to the above mentioned integrated gateway, the email message can be received by the gateway (via the base station) and can be used to distribute position-presence information to network devices without human intervention. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to

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further modify the above references with the teaching of Yugami for the advantage of obtaining position information of a mobile phone device without a user's intervention (see paragraph 0011). The above references do not explicitly teach about a toll-free telephone interface, as claimed by applicant. However, in the same field of endeavor, Barnett teaches about a mobile device initiating a toll-free call for reporting a GPS determined location information to a central hub (see at least col. 4, line 51-col. 5, line 3). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Barnett for the advantage of quickly notifying public or private authorities of stolen property using one of several available means (see col. 12-16).

**As per claim 2:** Polychronidis teaches a telecommunications system, wherein said positioning controller receives global positioning network signals for determining a position of an associated network client (see page 2, paragraphs 0020-0021).

**As per claim 3:** Polychronidis teaches a telecommunications system, wherein said communications controller comprises a cellular network controller for transmitting on a cellular telephone network to said positioning server (see abstract; figs. 1 and 2; page 1, paragraph 0021).

**As per claim 4:** some of the features of claim 5 are similar to the features of claim 1 and are rejected on the same ground and motivation as claim 1. Regarding the difference features, Polychronidis teaches about a telecommunications system:

wherein said positioning controller receives global positioning network signals for determining a position of an associated network client (see paragraph 0003);

wherein said communications controller comprises a cellular network controller for transmitting on a cellular telephone network to said positioning server (see figs. 1, 3, 4; paragraphs 0002-0003; 0021).

**As per claim 5:** the feature of claim 5 are similar to the features of claim 1, except a location control unit adapted to receive and maintain location information for said plurality of users, which is taught by Polychronidis (see fig. 4, elements 46 and 44); and an presence status –email, which is taught by Yugami teaches (see paragraph 0008). In Yugami, it is shown that a machine/device sends location information and/or location update information via e-mail without a user's intervention. The e-mailed location information is location status information. It is obvious presence status information could be sent in a similar manner. Hence, claim 5 is rejected on the same ground and motivation as claim 1.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claim 5 above and further in view of Chan (US 6,760,759 B1).

**As per claim 6:** but, the references applied to the rejection of claim 5 above, do not explicitly teach about, a telecommunication server, wherein said location control unit receives said location information via an enterprise specific dial-up, as claimed by applicant. However, in a related field of endeavor, Chan teaches about a system to support mobile visual communications wherein a mobile telephone is provided a wireless dial-up capability (see fig. 2, element 21; col. 1, lines 19-22; col. 4, lines 32-36). When the references are combined as shown, a remote device will be able to wirelessly dial-up to a location controller (HLR/MSC) and through the HLR/MSC to NPL Agent.



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Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Chan for the advantage of providing mobile devices with support system for dial-up internet communications.

Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polychronidis et al. (Polychronidis) (US 2003/0018704 A1) in views of McDowell et al. (McDowell) (US 2002/0035605 A1), Yugami (US 2003/0027583 A1), Barnett and further in view of Yoakum et al. (Yoakum) (US 6,658,095 B1).

**As per claim 7:** the features of claim 7 directed to position-presence correlation, email generation unit and the toll-free telephone interface are similar to the features of claim 1. Yugami also teaches that location update information can be sent via email message to a network (see paragraph 0008). Hence, the similar features of claim 7 are rejected on the same ground and motivation as claim 1. But, the combination of these references does not explicitly teach about presence correlation **rule**, as claimed by applicant. However, in a related field of endeavor, Yoakum teaches about a customized presence information delivery technique wherein presence rules defined by a user are utilized to deliver presence information (see col. 3, lines 47-61; col. 4, lines 49-56). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the above references with the teaching of Yoakum for the advantage of customizing the presence information provided by the modified Polychronidis' reference.

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**As per claim 8:** Polychronidis teaches about a telecommunications method, further comprising:

receiving positioning updates at said remote device (see page 3, paragraph 0036); and updates transmitting presence updates as one or more presence to other local controllers or remote devices as specified in said one or more positioning and presence correlation (see page 3, paragraph 36; page 4, paragraphs 0051-0063). It is known that the HLR, as a mobile user registers to a network, updates its location. But, Polychronidis does not explicitly teach the different features of claim 8, which are directed to transmitting, via email, presence correlation rules, to other local controllers or remote devices, as claimed by applicant. However, Yoakum teaches about a customized presence information wherein presence information is collected and delivered to subscriber based on rules/profiles defined by a user (see col. 2, lines 31-47; col. 4, lines 40-60), including transmitting, via email (see col. 7, line 50-col. 8, line 57), the presence/current information (based on the rules/profile) and dynamic location (location update) (see col. 5, lines 37-62) to subscribing devices. Motivation is same as provided in the rejection of claim 7.

**As per claim 9:** the feature of claim 9 is similar to the feature of claim 8, except one difference directed to receiving at a server one or more rules set via a network interface device operably coupled to said local controller, which is taught by Yoakum (see fig. 2, particularly, elements 52 and 62; col. 7, lines 10-35).

**As per claim 10:** Polychronidis teaches a telecommunications method, wherein said receiving positioning updates comprises receiving one or more signals from a global

positioning network (see page 2, paragraphs 0020-0021).

**As per claim 11:** Polychronidis teaches a telecommunications method, further comprising transmitting positioning information from said remote device to one or more servers via a radio-linked network (see figs. 1 and 2; abstract). Polychronidis does not explicitly teach about transmitting position updates, as claimed by applicant. However, Yoakum teaches about dynamically deriving location information from mobile terminals for use of customized presence service (see col. 5, lines 37-62). Motivation is as provided in the rejection of claim 8.

**As per claim 12:** Polychronidis teaches a telecommunications method, wherein said radio-linked network comprises a cellular telephone network (see abstract; figs. 1 and 2; page 1, paragraph 0021).

**As per claim 13:** Polychronidis teaches a telecommunications method, wherein said radio-linked network comprises a personal communication service (PCS) network (see page 5, paragraph 0066). PCS is provided by GSM.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polychronidis in views of Yugami (US 2003/0027583 A1) and Barnett.

**As per claim 14:** the features of claim 14 are similar to the features of claim 1, except an e-mail controller adapted to receive positioning information control updates from said associated server, which is taught by Yugami (see paragraph 0008). Yugami's reference teaches that a machine/device can communicate via e-mail without human/user's intervention. Hence, claim 14 is rejected on the same ground and motivation as claim 1.

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**As per claim 15:** Polychronidis teaches about a telecommunications device, wherein said positioning controller receives Global Positioning System (GPS) signals to determine said positioning information (see page 1, paragraph 0021).

Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 14 and 15 above, and further in view of Yoakum et al. (Yoakum) (US 6,658,095 B1).

**As per claim 16:** but, the references applied to claims 14 and 15 above, do not explicitly teach about a telecommunications device, further including a rules database of location and presence related information, as claimed by applicant. However, in a related field endeavor, Yoakum teaches about customized presence information delivery technique wherein presence information to subscribers is delivered based on rules stored in a rules management/database (see fig. 2, element 58; col. 2, lines 31-43; col. 4, lines 35-52). Note: when the references are combined as shown above, the modified reference would have included a rules management/database based on which location and presence information is delivered to subscribers. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Yoakum for the advantage of customizing user defined/customized presence information delivery system for subscribers.

**As per claim 19:** Yoakum teaches a telecommunications device, wherein said communications controller receives updates to said rules database as e-mails from said associated server (see col. 7, line 59-col. 8, line 13, lines 42-57).

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Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 14-16 above and further in view of Chan (US 6,760,759 B1).

**As per claim 17:** the references applied to claims 14-16, do not explicitly teach about a telecommunications device, wherein said communications controller transmits changes to location and presence status to said associated server via a wireless dial-up connection, as claimed by applicant. However, in a related field of endeavor, Chan teaches about a system to support mobile visual communications wherein a mobile telephone is provided a wireless dial-up capability (see fig. 2, element 21; col. 1, lines 19-22; col. 4, lines 32-36). Note: Presence-location service, including updating the service is provided in the above references. The clear difference between the above references and the feature of claim 17 is the wireless dial-up feature in claim 17, which is taught by Chan. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Chan for the advantage of providing mobile devices with support system for dial-up internet communications.

**As per claim 18:** the feature of claim 18 is similar to the feature of claim 17. A modified mobile device would be able to access the NPL service via wireless dial-up.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Appiah Charles can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Any inquiry of a general nature relating to the status of this application of proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Meless Zewdu

A handwritten signature in cursive script, appearing to read 'Zewdu, Meless', written in black ink.

Primary examiner

09 July 2007.